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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,023	10/01/2003	Phyllis A. W. Martin	0136.02	1052

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USDA-ARS-OFFICE OF TECHNOLOGY TRANSFER  
PATENT ADVISORS OFFICE  
WESTERN REGIONAL RESEARCH CENTER  
800 BUCHANAN ST  
ALBANY, CA 94710

EXAMINER

MARX, IRENE

ART UNIT PAPER NUMBER

1651

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



Art Unit: 1651

Applicant's election with traverse of Group I, claims 1-3 and 6. on 4/17/06 is acknowledged. The traversal is on the ground(s) that because the groups are classified in the same class and subclass, the "elected" subject matter would necessarily involve an overlapping search of the entire subject matter presently claimed.

However this is not found persuasive because the methods are of a different scope and the references which would be applied to one method would not necessarily anticipate or render obvious the other method. Regarding applicant's arguments that the Office has not demonstrated that the product can be made by another method, it is noted that the claims are directed to a species of *C. subtsugae* and that the product obtained has not been identified. Applicant has not provided any evidence on this record that all metabolites that are insecticidally active are only obtained from this species. As a matter of fact, *Chromobacterium* species are known to produce insecticidal products. See, e.g., Martin *et al.* (2001) or Martin (2002) of record, Abstract.

Moreover, as to the question of burden of search, classification of subject matter is merely one indication of the burdensome nature of the search involved. The literature search, particularly relevant in this art, is not co-extensive and is much more important in evaluating the burden of search. Burden in examining materially different groups having materially different issues also exists.

Clearly different searches and issues are involved with each group.

For these reasons, the restriction requirement is deemed proper and is adhered to. The restriction requirement is hereby made FINAL.

Claims 4,5 and 7-11 are withdrawn from consideration as directed to a non-elected invention.

The substitute specification is acknowledged and entered.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claim 3 is rejected under 35 U.S.C. 101 because this claim reads on the organism per se which is found in nature and thus, is unpatentable to applicant. Consequently, the claim does not embody patentable subject matter as defined in 35 USC 101. See, e.g., *American Wood v. Fiber Disintegrating Co.*, 90 U.S. 566 (1974); *American Fruit Growers v. Brogdex Co.*, 283 U.S. 1 (1931); *Funk Brothers Seed. Co. v. Kalo Inoculant Co.*, 33 U.S. 127 (1948); *Diamond v. Chakrabarty*, 206 U.S.P.Q. 193 (1980).

It is suggested that applicant use the language "a biologically pure culture" in connection with the strain to identify a product that is not found in nature and to indicate the hand of man.

### ***Claim Rejections - 35 USC § 112***

Claims 1-3 and 6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The invention appears to be directed to a novel strain of *Chromobacterium*. The written description of that strain and the method of isolating is insufficiently reproducible. Therefore, a deposit for patent purposes is required. The specification discloses at page 14 that strain *Chromobacterium subtsugae* has been deposited with the Agricultural Research Service Culture Collection (NRRL) under the provisions of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purpose of Patent Procedure and has been given the accession number NRRL B-30655B. For compliance with the rule, it must be averred that deposited material has been accepted for deposit under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the purpose of Patent Procedure (e.g. see 961 OG 21, 1977) and that all restrictions on the availability to the public of the material so deposited will be irrevocably removed upon the granting of a patent. MPEP 2403.

Additionally, the deposit must be referred to in the body of the specification and be identified by deposit (accession) number, date of deposit, name and address of the depository and the complete taxonomic description.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 1-3 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is incomplete in lacking punctuation.

Claim 2 is/are indefinite in the recitation of "the identifying characteristics", since it is unclear which characteristics are not identifying. It is suggested that the language --all of the identifying characteristics-- be substituted therefor.

Claim 6 is indefinite and confusing in that it is unclear that the strain of claim 1 in any amount would be useful for control of any and all insect pests.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Martin *et al.* (2002).

The claims are directed to any *Chromobacterium subtsugae* or to a strain having the identifying characteristics of NRRL B-30655 or a strain having a sequence of SEQ ID NO: 1.

The cited reference discloses a *Chromobacterium* which appears to be identical to the presently claimed strain (see, e.g., Abstract) since it produces insecticidal activity. The

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referenced microorganism appears to be identical to the presently claimed strain and is considered to anticipate the claimed microorganism since it belongs to the same genus, is of the same class as that of the microorganism claimed and is taught to be similarly effective against insect pests. Consequently, the claimed strain appears to be anticipated by the reference.

In the alternative, even if the claimed microorganism is not identical to the referenced microorganism with regard to some unidentified characteristics, the differences between that which is disclosed and that which is claimed are considered to be so slight that the referenced microorganism is likely to inherently possess the same characteristics of the claimed microorganism particularly in view of the similar characteristics which they have been shown to share. Thus the claimed strain would have been obvious to those skilled in the art within the meaning of USC 103.

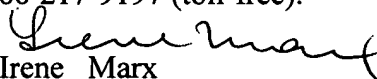
Accordingly, the claimed invention as a whole was at least prima facie obvious, if not anticipated by the reference, especially in the absence of evidence to the contrary.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 .

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Irene Marx  
Primary Examiner  
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